



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/840,527 | 04/23/2001 | Walter Navarrini | 2581/10 | 4854 |

26646 7590 09/09/2003

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

KEYS, ROSALYND ANN

ART UNIT PAPER NUMBER

1621

DATE MAILED: 09/09/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,527

Applicant(s)

NAVARRINI, WALTER

Examiner

Rosalyn Keys

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2003 and 16 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 21-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 21-26 are pending.
Claims 21-26 are objected.
Claims 1-20 are cancelled.

Election/Restrictions

2. Applicant's election without traverse of Group III, claims 21-26 in Paper No. 7 is acknowledged.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Italy on April 21, 2000. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b). The certified copy not provided is for MI2000 A 000902 filed in Italy on April 21, 2000.

Information Disclosure Statement

4. The information disclosure statement filed July 5, 2001 and September 9, 2002 have been considered.

Specification

5. The abstract of the disclosure is objected to because the word 'by' should be inserted between the words "obtainable" and "polymerizing" in line 8. Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities: the specification contains misspelled words and words that run together (see for example '—OCF₂Ogroup' on page 11, line 24 and 'peroxide/aminoimino- methansulphinic' on the last line of page 13 and page 43, line 6 0.

Appropriate correction is required.

7. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: oroperties (on page 1, line 14), asritisan (on page 17, line 16), poudered (on page 23, line 3) and ract (on page 24, line 3).

8. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

A substitute specification is required because the original specification contains many sentences which are unclear or incomplete. For example see page 1, lines 24-28; page 6, lines 18-22; page 7, lines 22-24; page 11, lines 27-31; the paragraph bridging pages 14 and 15; the last sentence on page 18; etc.

Art Unit: 1621

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01 (c). Correction of the following is required: the specification does not provide support for the residence time of 0.05 as disclosed in claim 23, line 5.

10. The use of the trademark FREON has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

11. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

12. Claims 21-25 are objected to because of the following informalities: the formula for the second olefin is inconsistent with the formula given on page 15, lines 6 and 12. Appropriate correction is required.

13. Claim 26 is objected to because of the following informalities: a space needs to be inserted between the word 'of' and the substituent R^A_1 of line 24. Appropriate correction is required.

Allowable Subject Matter

14. Claims 21-26 are allowable over the prior art of record.

Art Unit: 1621

15. The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to teach or fairly suggest making a fluorovinyl ether of the formula I by contacting hypofluorite with a first olefin to form a first intermediate hypofluorite and then contacting the first intermediate hypofluorite with a second olefin to form a second intermediate hypofluorite.

16. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Navarrini et al. (US 5,235,074) disclose reacting bis(fluoroxy)difluoromethane (BDM) with two particular olefins: tetrafluoroethylene and trans-1,2-dichloroethylene (see column 2, lines 11-15).

Worm et al. (US 6,255,536) disclose preparing perfluorovinyl ethers by using perfluoro alkyl hypofluorites and dichlorodifluoroethylene followed by dehalogenation using, for example, Zn (see column 1, line 54 to column 2, line 15).

18. This application is in condition for allowance except for the following formal matters:

See above objections to the specification and claims.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalyn Keys whose telephone number is 703-308-4633. The examiner can normally be reached on M and F 3:00-8:00 pm and T-R 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

R. Keys

R. Keys
September 5, 2003



Rosalyn Keys
Primary Examiner
Art Unit 1621